REMARKS

By this amendment, claim 1 has been amended. New claims 64-65 have been added. Claims 1-6 and 64-65 are pending in the application. Applicant reserves the right to pursue the original claims and other claims in this and other applications.

Claims 1-6 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation of "a location outside of a production facility of said die" derives support from paragraphs [0086]-[0089] of the specification, which describe exemplary embodiments in which the invention is used "in the field" and is tested and repaired after leaving the production facility. Applicant respectfully requests that the 35 U.S.C. § 112, second paragraph rejection of these claims be withdrawn.

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brauch et al. (US 6,550,023) in view of Wada et al. (US 6,138,257). This rejection is respectfully traversed. In order to establish a *prima facie* case of obviousness "the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. §2142. Neither Brauch et al. nor Wada et al., even when considered in combination, teach or suggest all limitations of independent claim 1.

Claim 1 recites, *inter alia*, a method of testing a memory die, comprising "testing said memory die; and storing at least a partial memory cell address on said die as a result of said testing act..., wherein said testing and storing acts are performed outside of a production facility of said die" (emphasis added). Wada et al. does not teach or suggest this limitation.

To the contrary, Wada et al. teaches that "it is absolutely necessary to inspect electrical characteristics of all or some of the IC devices at individual stages of manufacturing and testing stations." Col. 1, ln. 12-15 (emphasis added). As such, Wada et al. would not motivate one of skill in the art to perform testing of a memory die "outside of a production facility of said die." Wada et al. further teaches that "[i]n some cases, such defect analysis test is performed off the mass production line extractively for selected ones of the manufactured ICs rather than on the mass production line for every manufactured IC" Col. 2, ln. 41-44 (emphasis added). The phrase "off the production line," however, includes another location inside the same production facility in Wada et al. Applicant respectfully submits that "off the mass production line" does not teach testing a die and storing at least a partial memory address of the die outside of a production facility of said die as recited in claim 1.

Although the Office Action takes the position that the "production facility" can include the production line of Wada et al. alone, the interpretation is not consistent with how the term was used in the specification of this application, including, but not limited to paragraphs [0086] and [0089]. Nor is Brauch et al. cited for this limitation. Thus, Brauch et al. does not remedy the deficiency of Wada et al.

Further, "as a 'useful general rule,' ... references that teach away [from a particular combination] cannot serve to create a *prima facie* case of obviousness." *McGinley*, 262 F.3d at 1353-4, citing *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). Wada et al., in fact, teaches away from the claimed limitation as defined in the Office Action, teaching "[i]n some cases, ... defect analysis test is performed off the mass production line extractively ..., but such an extractive defect analysis test is not desirable from a viewpoint of quality control.... [T]o perform the defect analysis test for every manufactured IC, ... would ... present the problem that a longer test time is required." Col. 2, ln. 41-49 (emphasis added). Therefore, even if Wada et al. taught the cited

limitation, which it does not, there is no motivation to combine the cited references to produce the claimed invention, since Wada et al. would motivate one to not perform a defect analysis off the mass production line, given the problems (i.e., time and cost increases) associated with such a function as asserted in Wada et al.

Since Brauch et al. and Wada et al. do not teach or suggest all of the limitations of claim 1, claim 1 and dependent claims 2-6 are not obvious over the cited references. Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 1-6 be withdrawn.

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Dated: June 19, 2006

Respectfully submitted,

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